

### **REMARKS**

Claims 1-22 stand rejected. Applicant has amended Claims 2-9, 11, 13-18 and 20-22 to clarify their language and to correct various informalities. No surrender of claim scope is intended by the amendments. New Claims 23-37 have been added. Thus, Claims 1 to 37 are presently pending in this application. The amendments do not add new matter and find support throughout the Specification, Figures and Claims as originally filed.

Respectfully, Applicant requests reconsideration of the present application in view of the following arguments.

### **Claim Objections**

The Examiner has objected to Claim 16 as being cited twice. Accordingly, the Examiner has renumbered the second claim originally presented as claim 16 as claim 17 and claims originally presented as claims 17-21 as claims 18-22. Applicant has amended the claim numbering to reflect these changes and respectfully requests the objection be withdrawn.

### **Claim Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 15-16 stand rejected under 35 U.S.C. § 112, first paragraph, the Examiner contending they fail to comply with the written description requirement. Specifically, the Examiner states that there is no support for Claims 15 and 16 reciting the limitations "... adding an amount of money per ticket significantly less than the first -named prize pool." Applicant respectfully traverses this rejection, for at least the reason that these claims were part of the original disclosure.

In establishing a disclosure, Applicant may rely not only on the Specification and Figures as filed, but also on the original claims if their content justifies it. *See* MPEP § 608.04. Subject matter of an originally filed claim should not be attacked either by objection or rejections because its subject matter is lacking in the Figures and description. MPEP § 608.01(I).

For at least the foregoing reasons, Applicant kindly requests that the rejection of Claims 15-16 under 35 U.S.C. § 112, first paragraph be withdrawn.

Claim 19 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that there is no support for Claim 19 reciting the limitations "... identifying one of a plurality of specific games ...". Applicant respectfully traverses the rejection since, as stated above, subject matter of an originally filed claim should not be attacked either by objection or rejections because its subject matter is lacking in the Figures and description. MPEP § 608.01(I).

For at least the foregoing reasons, Applicant kindly requests that the rejection of Claim 19 under 35 U.S.C. § 112, first paragraph be withdrawn.

**Claim Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 16-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that there is insufficient antecedent basis for the term "second prize pool" recited in Claims 16-17. In addition, the Examiner states that there is insufficient antecedent basis for "winning another game ... holder is entitled to said other game" of Claim 18. The Examiner notes that there is a lack of consistency within the claim.

With regards to the term "second prize pool" in Claims 16-17, Applicant traverses the rejection. Claim 16 recites "a second prize pool" and thus, Applicant respectfully submits that there is sufficient antecedent basis for the term. Claim 17 has been amended to recite "a second prize pool" and thus, the rejection is moot.

Also for Claim 17, Applicant has amended Claim 17 to read "second prize pool" in the singular rather than plural form.

With regards to Claim 18, the claim has been amended to recite "winning the first lottery game." Applicant respectfully submits that this moots the § 112 rejection.

For at least the foregoing reasons, Applicant kindly requests that the rejection of Claims 16-18 under 35 U.S.C. § 112, second paragraph, be withdrawn.

**Claim Rejections Under 35 U.S.C. § 103**

**A. Claims 1-3, 10-11**

Claims 1-3, and 10-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,580,311 ("Haste") in view of U.S. Patent No. 4,982,337 ("Burr"). Applicant respectfully submits that neither Haste, Burr nor their proposed combination renders Claims 1-3, and 10-11 obvious for at least the following reasons.

To establish a *prima facie* case of obviousness, the prior art reference(s) must teach or suggest *all* the claim limitations. See MPEP § 2143. Applicant respectfully submits that neither Haste, Burr nor their proposed combination does this.

Applicant's amended Claim 1 recites:

*1. A gaming system comprising:  
a plurality of game tickets each having indicia for use in the  
play of a first lottery game and each also having a respective  
machine readable ticket code unique to that ticket in said system, the  
machine readable ticket code for use in the play of a jackpot game ...*

The Examiner relies on Haste for the game ticket of Applicant's Claim 1. Applicant respectfully submits that Haste does not disclose "a plurality of game tickets each having indicia for use in the play of a first lottery game and each also having a respective machine readable ticket code unique to that ticket in said system, the machine readable ticket code for use in the play of a jackpot game" as recited in Applicant's amended Claim 1. Rather, Haste's ticket is used for only a single type of game. Haste, 4:3-65. This differs from the limitations of Applicant's Claim 1 since recited ticket is used "in the play of a jackpot game" and the "first lottery game." The deal number of Haste is not related to any game play and is only used to verify whether the ticket is valid: "If the ticket number, roll number and deal number read from the ticket are the same as the corresponding numbers read from the memory module 30, the ticket is deemed to be valid and is dispensed from the machine. The corresponding ticket record in the memory module 30 is then erased, to preclude the possibility of tampering by reading the memory module a second time." Haste, 5:8-14. It is clear that Haste does not teach or suggest the ticket of Applicant's Claim 1.

Moreover, to reject, the Examiner must find a suggestion to combine the references that is "clear and particular". In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for "actual evidence" of the proposed motivation to combine. Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). Applicant respectfully submits that the Examiner has put forward no proper teaching or suggestion in the cited references that would lead an ordinary artisan to the proposed combination even if the proposed combination were arguably Applicant's claimed invention. *See* MPEP § 2143.01 ("obviousness can only be established by combining or modifying the teachings of the cited references to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art").

With respect to Claims 2-3, Applicant kindly requests that the rejection of these claims be withdrawn for at least the same reasons as for Claim 1 since Claims 2-3 ultimately depend from Claim 1.

Moreover, with respect to Claim 3, the Examiner states that "having the terminals connected on-line would be an obvious matter of design choice." Office Action, 10/16/2003, at 5. However, the Examiner points out no teaching or suggestion in the cited references that would lead an ordinary artisan to the proposed modification. If the Examiner is taking official notice of an alleged motivation, the Applicant respectfully traverses and requests the Examiner cite a reference or provide an affidavit in support of the rejection. *See* MPEP § 2144.03.

Similarly, with respect to Claims 10-11, the Examiner states that Claims 10-11 "recite the limitations of Claim 1 with the exception of the independent subsystems." Office Action, 10/16/2003, at 5-6. Accordingly, these Claims should be allowable for at least reasons similar to those given above for Claim 1.

In view of the foregoing, it is respectfully submitted that the Examiner's proposed combination of the references does not render obvious Applicant's Claims 1-3 and 10-11. Applicant respectfully requests withdrawal of the rejections to Claims 1-3 and 10-11.

**B. Claims 4-9**

Claims 4-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haste in view of Burr as applied to Claims 1-3 and 10-11 above, and further in view of U.S. Patent 5,944,606 ("Gerow"). Applicant respectfully traverses this rejection.

Applicant kindly requests that the rejection of these claims be withdrawn for at least the same reasons as for Claim 1 since Claims 4-9 ultimately depend from Claim 1.

With further regards to Claim 4, the Examiner states that "Haste in view of Burr both teach tickets bearing indicia covered with a removable object to be removed to play a lottery game. However, they both fail to provide one ticket indicating that it is a jackpot winner. Gerow teaches a progressive pull-tab gaming system where one of the cards indicates that it is a jackpot winner." Office Action, 10/16/2003, at 6. Applicant respectfully submits that this proposed combination does not render Applicant's claim obvious.

The Examiner continues to state that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the jackpot card as taught by Gerow in the Haste in view of Burr type system in order to have a more attractive payout and therefore attract more players." Office Action, 10/16/2003, at 6. If the Examiner is taking official notice of this alleged motivation, Applicant respectfully traverses and requests the Examiner cite a reference or provide an affidavit in support of the rejection. *See* MPEP § 2144.03. Applicant submits that this is a pure hindsight reconstruction, picking and choosing limitations from the references in an improper attempt to reconstruct Applicant's claimed invention.

In view of the foregoing, it is respectfully submitted that the combination of the references does not render obvious Claims 4-9. Applicant respectfully requests withdrawal of the rejections to Claims 4-9.

**C. Claims 12-18**

Claims 12-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerow in view of Haste. Applicant respectfully traverses this rejection.

Neither Gerow, Haste nor their proposed combination teaches “a gaming method comprising storing a plurality of gaming tickets in each of a plurality of gaming ticket dispensers, each of said tickets bearing indicia for use in the play of a first lottery game and each also having a respective machine readable ticket code unique to that ticket in said system, the machine readable ticket code for use in the play of a jackpot game” as recited in Applicant’s amended Claim 12. Gerow discloses a method of operating a progressive pull-tab game wherein a ticket purchaser plays a single game. *See* Gerow, Abstract. Gerow does not disclose the limitations of Applicant’s Claim 12 as amended and Applicant respectfully submits that the rejection to Claim 12 should be withdrawn.

In addition, Applicant respectfully submits that the Examiner identifies no teaching or suggestion in the cited references that would lead an ordinary artisan to the proposed combination even if the proposed combination were arguably Applicant’s claimed invention. *See* MPEP § 2143.01. If the Examiner is taking official notice of a motivation, the Applicant respectfully traverses and requests the Examiner cite a reference or provide an affidavit in support of the rejection. *See* MPEP § 2144.03.

Applicant kindly requests that the rejection to Claims 13-18 be withdrawn for at least the same reasons as for Claim 12 since Claims 13-18 ultimately depend from Claim 12.

Finally, Applicant kindly requests that the rejection to Claims 12-18 be withdrawn for at least similar reasons as presented above with respect to Claims 1-11.

**D. Claims 19, 20, 22**

Claims 19, 20, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerow in view of U.S. Patent 5,160,076 (“Ford”).

Applicant’s Claim 19 reads:

*19. A gaming method, comprising:  
providing a plurality of ticket dispensing machines;  
dispensing instant-winner lottery tickets from said  
machines, each instant-winner lottery ticket having information  
identifying one of a plurality of specific games in which the*

*ticket is issued, and having a removable cover over human-readable gaming information, each of said tickets also bearing machine-readable unique identification information; providing a jackpot prize pool which tickets from a plurality of said specific game are eligible to win; providing a code reader in each of said dispensing machines for reading said machine-readable identification information and producing corresponding signals; and detecting said signals to identify a winner of said jackpot prize.*

The Examiner proposes a combination of Gerow and Ford to reject Claim 19. Applicant respectfully submits that even if the proposed combination were Applicant's invention, the Examiner has not been provided a proper motivation to combine Gerow with Ford. The Examiner states that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the variety of tickets in one single unit as taught by Ford into the Gerow type device in order to attract different types of players." Office Action, 10/16/2003, at 9. As stated with reference to Claim 1 above, the present Office Action only offers a conclusory hindsight reconstruction and speculation that "it would have been obvious to one of ordinary skill in the art." If the Examiner is taking official notice of this alleged motivation, the Applicant respectfully traverses and requests the Examiner cite a reference or provide an affidavit in support of the rejection. *See* MPEP § 2144.03.

Furthermore, since Claims 20 and 22 ultimately depend from Claim 19, Applicant kindly requests that the rejection of Claims 20 and 22 be withdrawn for at least the same reasons.

Finally, Applicant kindly requests that the rejection to Claims 19, 20, and 22 be withdrawn for at least the same reasons as presented above with respect to Claims 1-18.

**E. Claim 21**

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerow in view of Ford as applied to Claims 19, 20 and 22, and further in view of U.S. Patent Re. 35,864 ("Weingardt").

Applicant respectfully requests that the rejection to Claim 21 be withdrawn for at least the same reasons as presented above with respect to Claim 19 since Claim 21 ultimately depends from Claim 19.

In addition, the Examiner again states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of pool shadow/seeding of Weingardt into Gerow in view of Ford type system in order to provide a more initial attractive pool at the beginning of the subsequent gaming session.” Office Action, 10/16/2003, at 10. Applicant respectfully traverses.

As stated above, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. *See* MPEP § 2143. Applicant respectfully submits that the Examiner has not identified any suggestion or motivation in the cited reference to combine Weingardt with the other references. If the Examiner is taking official notice of this alleged motivation, the Applicant respectfully traverses and requests the Examiner cite a reference or provide an affidavit in support of the rejection. *See* MPEP § 2144.03.

In view of the foregoing, Applicant kindly requests the rejection to Claim 21 under 35 U.S.C. § 103(a) be withdrawn.

#### **New Claims**

Claims 23-37 have been added. It is respectfully submitted that no new matter has been added and support for the new claims can be found in the original disclosure. In addition, new Claims 23-37 are allowable over the cited art of record for at least reasons similar to those given for the original claims.



Appl. No. 09/828,643  
Att. Docket No. 12406/102  
Reply To Non-Final Office Action of 10/16/2003


**CONCLUSION**

In light of the foregoing arguments, Applicant respectfully submits that all pending claims are in condition for allowance. The claimed invention is new, non-obvious, and useful. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

The Examiner is invited to contact the below-named attorney for any outstanding issues in connection with this application.

Respectfully submitted,  
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Dated: March 16, 2004

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